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EXAMINER

DAVIS, CASSANDRA HOPE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3611

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,095

Applicant(s)

COHN, BOB

Examiner

Cassandra Davis

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4, 7-9, 12, 13, 15, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart, U. S. Patent 5,284,365 in view of Miller.

With respect to claim 1 and 12, Stuart teaches a greeting card with and ornament for attachment to a Christmas tree. The ornament comprises a support member (Christmas tree); a plaque (support assembly 44) including a plate member (support member 54) and an adhesive layer (64) on opposite sides of the plate member 54 for adhering the picture (message inserts 42) to the plate member 54; and elastic loop or string 63 for hanging the ornament on the Christmas tree. Stuart teaches "a Christmas ornament hook member could be attached to the string loop member 63 for subsequent attachment to the limb of a Christmas tree for continued enjoyment. (Column 6, lines 52-55).

Stuart also teaches release layers 68 covering the adhesive layer.

Stuart does not teach the ornament having a swivel hanging means and personal photograph of a user.

Miller teaches a Christmas tree ornament swivel barrel type hook. (See figures 1-7). It would have been obvious to one having ordinary skill in the art at the time this invention was made to support the ornament taught by Stuart with a swivel hook as taught by Miller to provide a means so that the ornament can pivot freely.

Regarding claims 1 and 12, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide whatever indicia desired by the user (whether it be a personal photo or any other graphic indicia on the insert), since it would only depend on the intended use of the assembly and the desired information to be displayed.

Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information such as a personal image does

not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

With respect to claims 2 and 13, the plaque 44/54 taught by Stuart includes an adhesive layer 64 on opposed sides of the plaque member for adhering a first and second picture 42 thereto, wherein removable cover members 68 protect the adhesive. "During assembly, the cover member 68 is removed and the adhesive layer 74 bonds the primary message insert member 42 to the cylindrical support member 54." (See figures 4-5, column 5, lines 8-40 and claim 22)

With respect to claim 4 and 15, Stuart teaches the plate member can be comprised of a magnetic material. (See column 4, lines 46-53).

With respect to claim 7, Stuart teaches the support member has an inclined vertical member 62 for supporting the ornament on a tabletop. (See column 4, lines 63-68).

With respect to claim 8, Stuart teaches the support member (Christmas tree) is adapted to support a plurality of ornaments.

With respect to claim 9, Miller teaches the barrel type swivel hook.

With respect to claim 3 and 14, since the applicant does not disclose that constructing the plate member of paperboard material solves any stated problem or is for any particular purpose, it appears that construct the plate member of any suitable material as taught by Stuart would perform equally well in retaining the two picture on the opposite side thereof.

With respect to claims 25 and 27, since the applicant does not disclose that plate with edge forming a triangle, star, flower, diamond, oval, or heart solves any stated problem or is for any particular purpose, it appears that constructing the plate of any suitable shape as taught by Stuart would perform equally well in displaying the picture.

Claims 10, 11, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart in view of Miller applied to claim 1 and 12 above, and in further view of Ellison, U. S. Patent 6,230,425. Ellison teaches an ornament greeting card comprising an ornament with attachment means 4 and suction cup for attaching the ornament to a support surface such as a window. The ornament can be attached to windows or vertical surfaces by means of attachment means such as suction cups, releasable adhesive, permanent adhesive, hooks, a

refrigerator magnet, etc. It would have been obvious to one having ordinary skill in the art at the time this invention was made to substitute the hook for mounting the ornament taught by Stuart and Miller with a magnetic or suction cup attachment device as taught by Ellison to provide a means to removably attach the ornament against a surface.

With respect to claims 26 and 28, Ellison teaches the ornament having an aperture 2 through which the attachment means 4 may be inserted. Ellison also teaches the attachment means such as a "suction cup, a hook, a magnet for a refrigerator, an adhesive or semi-adhesive backed sticker with a peel-off backing, etc, is provided in a form so that a part of the attachment means can project through the aperture". (Column 4, lines 35-50).

3. Claims 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart in view of Miller as applied to claim 1 above, and further in view of Ochoa, U. S. Patent 6,113,994. Ochoa teaches a hanging figurine covered in a luminescent substance causing the figurine to glow when positioned in a dimly lit area. (Column 4, lines 40-55).

4. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the ornament taught by Miller

and Stuart with a luminescent substance as taught by Ochoa to provide a means to see the ornament in the dark or dimly lit area.

Response to Arguments

5. Applicant's arguments filed November 14, 2005 have been fully considered but they are not persuasive.
6. The applicant argues the Stuart does not teach a personal photograph of a user. The applicant points out [t]he present invention is not constructed with any predetermined message or artistic indicia as is the greeting card taught by Stuart.
7. As stated above, the examiner contends that use of a personal photograph goes to the type of indicia to be displayed. Since the indicia of a personal photograph does not have an unobvious functional relationship with the substrate (insert 16), it will not distinguish the invention from the prior art in terms of patentability.
8. The rejection is maintained.

Conclusion


9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cassandra Davis whose telephone number is 571-272-6642. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cassandra Davis
Primary Examiner
Art Unit 3611

CD
February 5, 2006